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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,246	04/26/2000	Nadia M. Corlett	9911-01	2384

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,246

Applicant(s)

CORLETT, NADIA M.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,9,11-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-15,21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,9,16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 10.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. During a telephone conversation with Eric Satermo on 10/17/02 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1, 4, 5, 9, 16, 19, and 20 in response to the restriction requirement mailed 10/02/02.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 11-15, 21, and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Status of Claims

2. Claims 2, 3, 6-8, 10, 17, and 18 have been cancelled. Claims 1, 4, 5, 9, 11-16, and 19-22 are pending, of which claims 11-15, 21, and 22 are withdrawn as being directed to a nonelected invention.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 4, 5, 9, 16, 19, and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(s) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 4, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Minton et al. USPN 5462166.

Regarding claims 1, 4, and 5, Minton discloses a highly compact (col. 6, lines 27-28) and portable absorbent article comprising a packaging 160. The article is reconfigurable from a normal condition to a compressed condition (see reference to col. 6 above). The article has three dimensions, of at least one being reduced when the article is compressed (col. 5, lines 2-17 and Figures 2-3). Minton further discloses a method for packaging and retaining the absorbent article (col. 5, lines 28-59).

With regard to the dimensions being reduced, the volume of space being reduced by a certain percentage upon compression, and retention of the article at negative pressure, these limitations are directed to an intended use of the article.

Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. The invention of Minton meets the structural limitations of claim 1 in that the absorbent article of Minton is capable of occupying a volume of space that is reduced by about 30% upon compression and the package is capable of retaining the article at negative pressure.

Regarding claim 9, Minton discloses the absorbent article may be a diaper (col. 3, lines 61-64).

6. Claims 1, 4, 5, 9, 16, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Meixner USPN 6321513.

As to claims 1, 9, 16, and 20, Meixner discloses a highly compact and portable absorbent article comprising a packaging and an absorbent article reconfigurable from a normal condition to a compressed condition; the absorbent article having three dimensions at least one of which is reduced when the absorbent article is in the compressed condition; the absorbent article occupying a volume of space that is reduced by at least about 30% when the absorbent article is reconfigured from a normal condition to a compressed condition (col. 4, lines 22-31), and the absorbent article being retained by the packaging when in a compressed condition.

As to claims 4, 5, and 19, Meixner discloses the absorbent article is reconfigured from a normal condition to a compressed condition by negative pressure, and the packaging is configured to retain at negative pressure the compressed absorbent article (col. 3, lines 46-63, col. 4, lines 22-32, col. 6, lines 4-12, and col. 9, lines 15-22).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, 5, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer USPN 4936460.

Regarding claims 1 and 16, Meyer discloses a highly compact and portable absorbent article and a method for packaging absorbent articles comprising providing a portable set of compact absorbent articles **10**, comprising a plurality of compartments (Figure 1) comprising a packaging **18** and an absorbent article (polyurethane foam may be used as filler, which is capable of absorbing liquids). The absorbent article is reconfigurable from a normal to a compressed condition in which the absorbent article is reduced by at least one dimension (Abstract). Meyer does not disclose the article occupies a volume of space, which is reduced by at least about 30% when the article is reconfigured from a normal to a compressed condition. Meyer discloses the article is

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reduced by 20% (Abstract, col. 1, lines 29-33). However, unless applicant can show criticality for claiming a particular particle size, it is not novel to claim a specific size. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding claim 4, Meyer discloses the packaging is configured to retain at negative pressure the compressed absorbent article (col. 1, lines 28-33).

Regarding claim 5, Meyer discloses the absorbent article is reconfigured from a normal condition to a compressed condition by negative pressure (col. 2, lines 33-37).

Regarding claim 19, Meyer discloses the packaging is configured to retain at negative pressure the compressed absorbent article (col. 1, lines 28-33).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761



January 14, 2003



WEILUN LO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700